

**AMENDMENTS TO THE DRAWINGS:**

The attached sheet of drawings includes amendments to FIG. 2. This sheet replaces the original sheet that contains FIG.2. In FIG.2., the reference character "91" has been deleted and replaced (or added) with the reference character "90."

Attachments: Replacement Sheet

**REMARKS**

Claims 1-37 are pending in the present application.

Claim 38 has been added. Support for Claim 38 is found at page 25, [0092].

Claims 1, 5, 9-11, 13-14, 17-18, 21-22, 24-25, 27-29, and 31-37 have been amended for clarity and/or to provide antecedent basis. Support for the amendment is found throughout the specification.

The claimed electrically heated cigarette is structurally distinguishable from lit-end cigarettes in that the claimed electrically heated cigarette includes "a tobacco-containing mat having a tubular form and incorporated into a tobacco rod of the electrically heated cigarette." Lit-end cigarettes do not.

In particular, support for the amendment of independent claims, such as Claims 1, 31, 33, 34, and 36, reciting the phrase "a tobacco-containing mat having a tubular form and incorporated into a tobacco rod of the electrically heated cigarette," is found on page 8, paragraphs [0031] and [0032].

FIG. 1 illustrates a partially unassembled view of an embodiment of an electrically heated cigarette. FIG. 2 illustrates an assembled view of an embodiment of an electrically heated cigarette. The electrically heated cigarette (23) includes at least a tobacco rod (60) portion juxtaposed end-to-end with a filter tipping (62) portion. The filter tipping (62) portion includes a mouth piece filter plug (94) intended to make contact with a smoker's mouth. The tobacco rod (60) portion includes the recited element, "tobacco-containing mat 66," and is the portion of the claimed electrically heated cigarette intended to be inserted in the opening or "the cigarette receiver 27" of "a reusable lighter 25" illustrated in FIGS. 4 and 5 (See [0081] - [0088]). The "tobacco-containing mat 66" is described in the specification as "folded in a tubular form ...." (see [0030]).

Furthermore, the specification and the drawings have been amended to address the Examiner's objections described further below. No new matter has been added. Favorable consideration is respectfully requested in view of the following remarks.

### **Objections to Drawings and Specification**

*The Official Action objects to the drawings under 37 C.F.R. §1.84(p)(5) for the reason stated at page 2, in that the reference character (91) is neither disclosed nor described in the specification.*

It is noted that the reference characters "90" and "91" appear in the original specification to describe a void (See [0093] and [0094]), and accordingly, the reference character "91" should be replaced with "90." Applicants note that paragraphs [0093] and [0094] have been amended to correct this typographical error. Furthermore, FIG. 2 has been correspondingly amended to replace the reference character "91" with "90." Applicants submit that the amendments to the specification and the drawings address the objection, and respectfully requests the withdrawal of this objection.

### **Claim Objections**

*The Official Action objects to Claim 29, under 37 C.F.R. § 1.75(c), for improper dependent form by failing to further limit the subject matter of a previous claim. In particular, the reference to fibers, as either in continuous form or non-continuous form, is allegedly inclusive of all fibers, and thus places no further limitation on the parent claim.*

Claim 29 has been amended to recite a suitable range of fiber lengths. Support for the amendment of Claim 29 is found at page 12, [0049]. Applicants submit that the amendment to Claim 29 addresses the objection, and respectfully requests the withdrawal of this objection.

### **Rejections Under 35 U.S.C. § 112**

*Claims 25, 30, and 35 stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. In particular:*

*Claim 25 that recites the inclusion complex of Claim 22 that comprises "up to about 20% of the flavoring" is allegedly indefinite because the measurement basis for this claim was not clearly set forth (e.g., weight percent, mole percent, etc.).*

Claim 24 recites, as amended, "The electrically heated cigarette of Claim 22, which comprises less than about 15% by weight of the inclusion complex, based on the weight of an over wrap and/or mat." Claim 25 recites "The electrically heated cigarette of Claim 22, wherein the inclusion complex comprises up to about 20% of the flavoring." The "inclusion complex" recited in Claim 25 is intended to modify the "inclusion complex" recited in Claim 24. Thus, Claim 25 has been amended to depend on Claim 24 and not Claim 22. Support for the claim amendment is found in the specification, at page 15, paragraph [0061]. Based on this amendment, Applicants respectfully request the withdrawal of the 35 U.S.C. § 112, second paragraph rejection.

*Claim 30 that recites "the fibers are impregnated with at least one sorbent" and the parent claim 28 that recites the "sorbent is fibers" allegedly sets forth an equivalency between the sorbent and fibers, so that Claim 30 essentially reads as wherein "the (sorbent) is impregnated with at least one sorbent." It is allegedly unclear how the applicant intends to limit the parent Claim 28 in Claim 30.*

Claim 28 has been amended to recite the "electrically heated cigarette of Claim 1, further comprising a filter having fibers incorporated therein." Support for the amendment of Claim 28 is found throughout the specification, and at page 12, paragraphs [0051-0052]. Based on this amendment, Applicants respectfully request the withdrawal of the 35 U.S.C. § 112, second paragraph rejection.

*Claim 35 that recites "the flavoring-release additive" comprises at least two "flavoring-release additives" is allegedly indefinite because it is unclear how a thing is able to comprise itself.*

Claim 35 has been amended to recite "the electrically heated cigarette of Claim 34, which comprises at least two flavoring release additives in the form of ..." (emphasis added). Based on this amendment, Applicants respectfully request the withdrawal of the 35 U.S.C. § 112, second paragraph rejection.

#### **Rejections Under 35 U.S.C. § 102**

*Claims 1-15, 17-23, 25-32, and 34-37 stand rejected under 35 U.S.C. § 102(e) in view of Shi ("Shi") (US 2005/0000531 A1). The Official Action alleges that*

*"Shi teaches a method of adding a flavorant to a smoking article via the microencapsulation of said flavorant within a material having a melting point below the pyrolysis zone temperature of the smoking article" (see pages 4-12 of the Official Action).*

MPEP §2131 provides that a claim is deemed anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (emphasis added; MPEP quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2USPQ2d 1051, 1053 (Fed. Cir. 1987)). Thus, a proper *prima facie* case of anticipation requires that a single reference is provided by the Examiner that discloses each of the claimed elements as interpreted by one of ordinary skill in the art.

Applicants traverse the rejection of Claims 1-15, 17-23, 25-32, and 34-37 under 35 U.S.C. § 102(e), and assert that *Shi* does not disclose the combination of features recited in independent Claims 1, 31, 34, and 36, each of which recites "a tobacco-containing mat having a tubular form." The Official Action stated that the "limitations of 'Electrically heated' and 'electrical' as recited in the preamble to Claim 1" were "understood to place neither an explicit nor an implicit limitation on the structure of the claimed cigarette and smoking system." Because *Shi's* lit-end cigarette lacks the recited "tobacco-containing mat," *Shi* fails to disclose the claimed electrically heated cigarette. Thus, Applicants assert that the withdrawal of the § 102 rejection of Claims 1-15, 17-23, 25-32, and 34-37 is believed to be in order, and respectfully request the withdrawal of this rejection.

### **Rejections Under 35 U.S.C. § 103**

*Claims 7, 16, 19, 23-25, 27, and 33 stand rejected under 35 U.S.C. § 103(a) in view of the cited references. In particular, Claim 7 stands rejected in view of Shi (US 2005/0000531 A1) and Wakamiya et al. ("Wakamiya")(US 6,056,974); Claim 16 stands rejected in view of Shi; Claim 19 stands rejected in view of Shi and Bradley et al. ("Bradley") (U.S. 4,195,645); Claims 23-25 stand rejected in view of Shi and Demain (U.S. 5,144,946); Claim 27 stands rejected in view of Shi; and Claim 33 stands rejected in view of Shi (See Official Action, at pages 12-17).*

MPEP §2143 provides that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure." (MPEP sec. 2143 quoting *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Applicants traverse the rejection of Claims 7, 16, 19, 23-25, 27, and 33, and assert that the cited references alone, or in combination, do not suggest the claimed electrically heated cigarettes recited in independent Claim 1, and certainly do not suggest the claimed electrically heated cigarettes recited in dependent claims, Claims 7, 16, 19, 23-25, and 27. As explained above, *Shi* fails to disclose the claimed electrically heated cigarette comprising at least a tobacco-containing mat, at least one sorbent, and at least one flavoring-release additive. None of these secondary references remedy the deficiency of *Shi*, and accordingly, Applicants respectfully request the withdrawal of the rejection of Claims 7, 16, 19, 23-25, and 27.

With respect to Claim 33, Applicants assert that *Shi* fails to disclose the claimed electrical smoking system comprising a lighter; and at least one electrically heated cigarette comprising at least a tobacco-containing mat, at least one sorbent, and at least one flavoring-release additive.

Claim 33, as amended, recites "An electrical smoking system, comprising:  
a lighter having electrically heated heating elements; and  
at least one electrically heated cigarette including:

a tobacco-containing mat having a tubular form and incorporated into a tobacco rod of the electrically heated cigarette;  
at least one sorbent; and  
a flavoring-release additive including at least one flavoring.

wherein the flavoring is releasable from the flavoring-release additive by heating the electrically heated cigarette to at least a minimum temperature within the electrical smoking system that generates tobacco smoke without combustion of the electrically heated cigarette." (emphasis added)

The Official Action alleges that it would be obvious to engage in smoking of a cigarette as taught by *Shi* by pairing the disclosed smokable cigarette with a heat source or a "lighter" capable of igniting said smokable cigarette (See page 33, lines 10-17). In the specification, FIGS. 4 and 5 provide an illustration of one embodiment of the claimed electrical smoking system (see [0081] - [0088]). The specification provides that the claimed

"electrical smoking system 21 includes an electrically heated cigarette 23 and a reusable lighter 25. The cigarette 23 is constructed to be inserted into and removed from a cigarette receiver 27, which is open at a front end portion 29 of the lighter 25. Once the cigarette 23 is inserted, the smoking system 21 is used in a similar manner as a more traditional cigarette, but without lighting or smoldering of the cigarette 23." (emphasis added) (See at page 22, [0081])

"The lighter 25 includes a housing 31 having front and rear housing portions 33 and 35, respectively. A power source 35a, such as one or more batteries, is located within the rear housing portion 35 and supplies energy to a heater fixture 39. The heater fixture 39 includes a plurality of electrically resistive, heating elements 37 (FIG. 6). The heating elements 37 are arranged within the front housing portion 33 to slidably receive the cigarette 23." (emphasis added) (See at page 22, [0082])

"When a cigarette 23 is properly positioned against a stop 182 (FIG. 2) within the lighter of the electrical smoking system, a portion of each heating element contacts the tobacco rod 60. This region of contact is referred to as a heater footprint 95, which is that region of the tobacco rod 60 where the heating element 37 is expected to reach a temperature high enough to allow smoking of the cigarette without combustion of the cigarette paper, mat or tobacco." (emphasis added ) (See at page 25, [0092]).

Applicants submit that the lighter having electrically heated heating elements recited in Claim 33 is not the equivalent of conventional lighters, in that the lighter recited in Claim 33 is not powered by a cigarette-lighter fluid as a flame-generating source. *Shi* fails to disclose the lighter of Claim 33, and therefore, *Shi* also fails to disclose the claimed electrical smoking system of Claim 33. Thus, Applicants submit that the claimed electrically heated cigarette (recited in Claims 1-30), and the claimed electrical smoking system (recited in Claims 33 and 38) are not obvious in

view of the cited references, and therefore request the withdrawal of this rejection.

**CONCLUSION**

From the foregoing, further and favorable action in the form of Notice of Allowance is respectfully requested and such action is earnestly solicited.

In the event that there are any questions relating to this Amendment or the application in general, it would be appreciated if the Examiner would contact the undersigned attorney by telephone at (703) 838-6671 so that the prosecution of the application may be expedited.

Respectfully submitted,

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